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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/178,329  | 10/23/1998  | MICHAEL R. NOWAK       | E4919-00003         | 4360             |
| 8933 7590 10/07/2009<br>DUANE MORRIS LLP - Philadelphia<br>IP DEPARTMENT<br>30 SOUTH 17TH STREET<br>PHILADELPHIA, PA 19103-4196 |             |                        |                     |                  |
| EXAMINER<br>JACKSON, MONIQUE R  |             |                        |                     |                  |
| ART UNIT<br>1794  |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>10/07/2009   |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/178,329

## Applicant(s)

NOWAK ET AL.

## Examiner

Monique R. Jackson

## Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25, 26, 28-35 and 37-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 26, 28-35 and 37-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 6/25/09, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794

***Claim Rejections - 35 USC § 103***

2. Claims 25, 26, 28-35 and 37-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Peer Jr (USPN 4,254,173.)

3. The admitted prior teaches a ream of paper wrapped by a wrapping material comprising a paper layer and polymer and/or wax coating, particularly polyethylene coating, to provide a moisture barrier for the ream of paper (Pages 1-2), but do not teach that the wrapping material is formed from a polymer film adhered to the paper layer with an adhesive and is printed before lamination as in instant Claim 25. However, Peer Jr teach a composite material for packaging comprising a paper substrate laminated to a plastic film via an adhesive layer which provides improved tear resistance and higher strength to the paper composite, wherein the plastic film is preferably transparent to permit reverse printing on the inner surface and provide abrasion resistance to the decoration visible through the film (Abstract; Col. 8, lines 40-60.) Peer Jr teach that the plastic film is preferably polyethylene, polypropylene, polyester, polyvinylchloride or cellophane; and the adhesive may selected based upon compatibility with the film but is preferably molten polyethylene (Abstract; Col. 4, lines 1-19.) Hence, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any polymer coated packaging material for the wrapped ream of paper wherein Peer Jr teach a composite as instantly claimed which provides improvements over other packaging materials.

4. With regards to further dependent claims, Peer Jr teach that pigments and other additives can be added if desired, wherein the Examiner takes the position that wax is a conventional additive utilized in the art as evidenced by the admitted prior art (Col. 4, lines 6-9.) With respect to metallized material limitation, Peer Jr further teach that after printing, the plastic film can be metallized (Col. 3, lines 31-35.) With respect to Claims 34 and 51, wherein the paper substrate is printed vs. the polymer film, the Examiner takes the position that the final end product having an intermediate print layer would be the same regardless of which layer is printed. In addition, it

would have been obvious to one having ordinary skill in the art to provide print on the inner surface of the paper, if desired, for decorative purposes, given the reasonable expectation of success and predictable results wherein the resulting printed image would still be present between the paper and the film as taught by Peer Jr.

***Response to Arguments***

5. Applicant's arguments with respect to claims 25, 26, 28-35 and 37-58 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Monique R Jackson/

Primary Examiner, Art Unit 1794

October 1, 2009